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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/647,207 | 08/26/2003 | Ryoji Watanabe | 116872 | 1938 |
| 7590 OLIFF & BERRIDGE P. O. BOX 19928 ALEXANDRIA, VA 22320 | | 10/31/2007 | EXAMINER GETANEH, MESFIN S | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|---------------------------------|--|
| Office Action Summary | Application No. 10/647,207 | Applicant(s) WATANABE ET AL. | |
| | Examiner Mesfin Getaneh | Art Unit 4157 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The IC chip IF 28-2 described in [0054] is not labeled in Fig. 3. Fig. 3 has a label (28-3) which is not described in the specification. First printing program 5 in [0078] is not shown in Fig. 7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The disclosure, referencing from the application publication # US 20040046985 A1, is objected to because of the following informalities: the memory circuit 322 in Fig. 5 is described as memory circuit 324 in [0071]. The reception circuit 286 in Fig. 6 is described as the reception circuit 296 in [0082]. The paper tray described in [0098] is not shown in Fig. 2 as described, but in Fig. 3. Appropriate correction is required.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claim 9 and 10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 9 as recited is not patent eligible. See MPEP 2106.01 (I). Specifically, "A program making a computer execute a process" does not fall within a statutory category of a machine, an article of manufacture, a composition of matter, or a process because it is not clear whether a "program" as recited is for causing the computer to execute it as claimed. It could very well imply manual operation of turning on a computer to perform a process. Also it has to be recited as being embedded in a computer readable medium. The claim could be remedied by reciting "a computer (software) program encoded in a computer-readable medium when executed by the computer comprising: outputting a first parameter indicating at least one of a way to form an image, which is displayed on a image display member, and a formation history of the displayed image to an external by the image display member; reading the displayed image from the image display member; reading the output first parameter; and forming the read image on the basis of the read first parameter on a recording medium. "

In claim 10, "the program" also falls under non-statutory subject matter because of the same reasoning as claim 9. (See claim 9)

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claim 1-10** are rejected under 35 U.S.C. 102(e) as being anticipated by Teraura (Pub US 20020170973).

With regards to **claim 1**, Teraura discloses an image forming system (copy machine with a facsimile function in FIG. 2) comprising: an image display member on which an image is displayed (Printing paper 13 of FIG. 3); and an image forming apparatus (FIG. 2), wherein: the image display member includes: a first parameter storage unit stores a first parameter indicating a way to form the displayed image and a formation history of the displayed image and outputs the stored first parameter to an external (control programs and various data are stored in the ROM 23 memory circuit in FIG. 3A [0076] of the RFID tag 14); and the image forming apparatus includes: an image reading unit for reading the displayed image (a scanner 6 of FIG. 2 reads an image on the sheet of document paper [0068] and [0069]); a parameter reading unit for reading the output first parameter (the control circuit 29 in FIG. 5 controls the first reader-writer 15 to read the data in the RFID tag 14 [0087]); and an image forming unit

for forming the read image on the basis of the read first parameter on a recording medium (printing unit 11 in FIG. 5 prints image as determined by the control circuit 29 on a printing paper with RFID tag [0082]):

With regards to **claim 2**, which further limits claim 1, wherein: the recording medium includes a second parameter storage unit for storing the first parameter written from the external and outputting the stored first parameter to the external (the control circuit 29 controls the third reader-writer 15 to store data in the RFID tag 14 to print it on printing paper with RFID tag [0087]); and the image forming apparatus includes a parameter writing unit for writing one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into the second parameter storage unit (the third reader-writer stores the data read from the RFID tag 14 on the sheet of document paper 61 and the stored (inputted) data in the RFID tag 14 of the sheet of the printing paper 13 [0092]).

With regards to **claim 3**, Teraura discloses an image forming apparatus copy machine with a facsimile function in FIG. 2) comprising: an image reading unit for reading an image displayed on an image display member (a scanner 6 of FIG. 2 reads an image on the sheet of document paper [0068] and [0069]); a parameter reading unit for reading a first parameter indicating at least one of a way to form the displayed image and a formation history of the displayed image from the image display member (the control circuit 29 in FIG. 5 controls the first reader-writer 15 to read the data in the RFID tag 14, formation history in this case includes input or permission data [0087] and [0088]); and an image forming unit for forming the read image on the basis of the read

first parameter on a recording medium (printing unit 11 in FIG. 5 prints image as determined by the control circuit 29 on a printing paper with RFID tag [0082]).

With regards to **claim 4**, which further limits claim 3, comprising: a parameter writing unit for writing one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into a storage unit of the recording medium (the second 16 and third reader-writers 17 record RFID data [0071], RFID data includes printing parameter and formation history in this case includes input or permission data [0087] and [0088]).

With regards to **claim 5**, which further limits claim 4, wherein the first parameter includes information indicating a mode for forming the displayed image on the recording medium, a size of the formed image, and number of the image formation (the first parameter information mentioned in this claim are just data that can be sent any external apparatus such as PC 39 in FIG. 5. Teraura teaches some of the data that can be incorporated; the inputted identification data is recorded in the RFID tag of the sheet of printing paper in the copying mode, and the RFID data from the sheet of document paper 61 is recorded in the RFID tag of the sheet of the printing paper [0121], the control circuit 29 selects the paper tray 7 containing sheets of the printing paper 13 having the selected size with the RFID tags 14 and feeds a sheet of the printing paper 13 to the printing paper feeding path 9 from the selected paper tray 7 [0083]. Although, Teraura does not state number of the image formation, it will be known to one skilled in the art to supply the number of image formation as a printing parameter).

With regards to **claim 6**, which further limits claim 4, wherein the history contained in the second parameter includes at least a size change of the image formed on the recording medium (the digital data that can be stored on the sheet of the printing paper 13 with the RFID tag can be any information that can include a size change of the formed image. Teraura teaches some of the data that can be incorporated in [0111]).

With regards to **claim 7**, a method (the apparatus as claimed in claim 1 inherently implies the method as claimed) for forming an image, which is displayed on an image display member, on a recording medium, the method comprising: outputting a first parameter indicating at least one of a way to form the displayed image and a formation history of the displayed image to an external by the image display member; reading the displayed image from the image display member; reading the output first parameter; and forming the read image on the basis of the read first parameter on a recording medium.

With regards to **claim 8**, the method according to claim 7 (the apparatus as claimed in claim 2 inherently implies the method as claimed), further comprising: storing a parameter written from the external and outputting the stored parameter to the external by the recording medium; and writing one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into the recording medium.

With regards to **claim 9**, a program making a computer execute a process comprising: outputting a first parameter indicating at least one of a way to form an image, which is displayed on a image display member, and a formation history of the

Art Unit: 4157

displayed image to an external by the image display member; reading the displayed image from the image display member; reading the output first parameter; and forming the read image on the basis of the read first parameter on a recording medium (claim 9 is nothing more than a computer program performing the operation the steps of claim 7 using the apparatus of claim 1. Using a computer program to perform these kinds of tasks is well known in the art. The PC 39 in FIG. 5 can be programmed to perform these tasks).

With regards to **claim 10**, the program according to claim 9, wherein the process further comprises: storing a parameter written from the external and outputting the stored parameter to the external by the recording medium; and writing one of the read first parameter and a second parameter containing a history updated in response to the image formation on the recording medium into the recording medium (the same rationale as claim 9).

Conclusion

7. Kanazawa et al. (US 20020051161) teaches an image forming apparatus, an image forming system, and a sheet feeding source designation control method, which are capable of preventing a user from failing to carry out proper settings to thereby avoid printing using an undesired sheet cassette.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mesfin Getaneh whose telephone number is (571) 270-3752. The examiner can normally be reached on 8:00AM-5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vu Le can be reached on (571) 272-7332. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mesfin Getaneh/

Patent Examiner


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SUPERVISORY PATENT EXAMINER